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EXAMINER	
TADGARD	
ART UNIT	PAPER NUMBER
172	5

DATE MAILED: ~~11/19/82~~

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

JAN 18 1983

☐ This application has been examined. ☒ Responsive to communication filed on JULY 1, 1982 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892 | 2. <input type="checkbox"/> Notice of Informal Patent Drawing, PTO-948 |
| 3. <input type="checkbox"/> Notice of References Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-3 are pending in the application.
Of the above, claims — are withdrawn from consideration.
2. ☐ Claims — have been cancelled.
3. ☐ Claims — are allowed.
4. ☒ Claims 1-3 are rejected.
5. ☐ Claims — are objected to.
6. ☐ Claims — are subject to restriction or election requirement.
7. ☐ The formal drawings filed on — are acceptable.
8. ☐ The drawing correction request filed on — has been ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. —,
filed on —.
10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
11. ☐ Other

The disclosure is objected to as failing to provide an enabling disclosure as required by the first paragraph of 35 U.S.C. 112. This paragraph of the statute, requires that the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The Rowland letter of April 8, 1981 and the Brandon letter of April 26, 1981 have been considered. However, the "permanent availability" has not been established. The Brandon letter indicates that the fee has not been paid and its receipt is required for the deposit to be maintained. The Rowland letter indicates that the responsibility for replacement of the deposit lies with the Regents of the University of California. However, it is not evident from the record if 1) the fee has been paid and 2) if the Board of Regents will replace the deposit. Submission of such proof would obviate this objection. Accordingly, the objection is deemed proper and repeated.

Claims 1 and 2 rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the preceding paragraphs.

The claims are based on an inadequate disclosure. Note the objection above.

Claim 3 is rejected under 35 U.S.C. 103 as being unpatentable over Ham et al taken in view of Kohler et al and Iscove et al. Although, the invention is not identically disclosed or described as set forth in section 102 of Title 35 U.S.C., the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

The basis for this rejection was set forth in the first office action. Applicant urges that a thousand fold increase in fusion frequency renders the cell line and the method of producing the cell line unobvious. Applicant further urges unexpected results achieved from a conventional process.

The unexpected high fusion frequency does render the cell line unobvious since these characteristics are inherently present in the cell line. However, claim 3 is not limited to either one of

the two critical factors; namely, the degree of enhanced fusion frequency obtained ^{over} the particular parent cell line or the conditions responsible for the increased rate. Due to the naturally large variation in fusion frequency in various conventional cell fusions, a claim limited merely to "enhancing fusion frequency" does not sufficiently define this critical feature. Since applicant's attorney admits (page 2 line 28-29) that the mechanism is not known, and since the method has been shown to work with only one cell line, the particular cell line appears critical. Note that this method has not been shown to be repeatable, much less workable with any related cell line, even less with any human cell, and even less with cells from any animal as is so claimed. Accordingly, in the absence of these critical features or data showing widespread applicability, claim 3 appears to read on an obvious method to reduce fetal calf serum dependence with natural variations in fusion frequency as is set forth in the first office action.


Claims 1 and 2 are free of prior art.

THIS ACTION IS MADE FINAL.

J.E.T.
J.E.TARCZA:dt

11/12/82

703-557-3618


THOMAS G. WISEMAN
EXAMINER
BOARD OF PATENT APPEALS